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EXAMINER

LE, LINH GIANG

ART UNIT

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/672,829	<b>Applicant(s)</b> MCGLOIN ET AL.	
	<b>Examiner</b> MICHELLE LE	<b>Art Unit</b> 3686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 42-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 42-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>062609</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 18 June 2009 has been entered. Claims 42-61 remain pending. Claims 41, 44, and 56-61 have been amended.

### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on 26 June 2009 before the filing of a first Office action after the filing of a request for continued examination under 37 CFR 1.114. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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4. Claims 42-55 remain rejected under 35 USC 101.

5. The claimed invention is directed to non-statutory subject matter. Claims 42-55 remain rejected under 35 U.S.C. 101 based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *In re Bilski et al*, 88 USPQ 2d 1385 CAFC (2008); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).

There are two corollaries to the machine-or-transformation test. First, a mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent- eligible. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such a data gathering or outputting, is not sufficient to pass the test.

Applicant has added the limitation “wherein at least one of the steps are implemented at a performance transaction server.” The newly added limitation to

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independent claim 42 does not overcome the rejection under 35 USC 101 as it still does not pass the "machine or transformation" test. To be statutory, the claimed limitations must require the method be implemented by a particular machine. The newly added limitation only requires one of the steps to be implemented at a performance management transaction server. This does not make clear whether the server is doing the actual processing or the steps are merely occurring at the server.

Furthermore, it is required that the particular machine impose a meaningful limit on the claim scope. In other words, the use of a particular machine must be more than a field of use limitation and involve more than insignificant extra-solution activity. However, the newly added limitation only requires at least one of the steps to be implemented at a server. Thus the server may only be involved in the data gathering and outputting steps and would hence not impose a meaningful limit on the claim scope.

Independent claim 56 has been amended to include the information management function executed on a performance management transaction server. Thus, under a broadest reasonable interpretation standard claim 56 includes a structural limitation (transaction server) and qualifies as patent eligible subject matter. Furthermore, since the information management function is applied to create an individual performance measurement the claim as a whole has real world use and does not cover substantially all practical uses of a judicial exception. The rejection of claim 56 under 35 USC 101 is withdrawn.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 56-61 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 56 includes the limitation of "an information management function...to receive performance management data, apply the received performance management data..., and create...an individual performance measurement ...". It is unclear which structure is performing the applying and creating functions. Examiner will interpret the claim as the information management function executed on a performance management transaction server performing the above recited functions. It is suggested that Applicant amends the claims to recite the information management function "to receive performance management data, to apply the received performance management data... and to create...an individual performance measurement..."

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 42-61 rejected under 35 U.S.C. 103(a) as being unpatentable over Powers (6,615,182) in view of Wolfston (5,815,155).

10. As per claim 42, Powers teaches a computer-implemented performance management method operable in an enterprise comprising individuals organized according to a hierarchy, the method comprising:  
providing a user interface by which a user defines a data dictionary, the data dictionary defining processing of performance management data, wherein the data dictionary comprises one or more data fields, an operator for defining an operation to be applied to performance management data in at least one of the data fields, (Powers; Col. 1, line 60 to Col. 2, line 12; Col. 11, line 64 to Col. 13, line 42) ;  
receiving performance management data (Powers; Col. 4, line 54 to Col. 5, line 2);  
applying the received performance management data against the data dictionary (Powers; Col. 11, line 64 to Col. 13, line 42); and  
creating for an employee an individual performance measurement according to the operation at the user-selectable level of the hierarchy (Powers; Col. 4, line 21-41).

Powers does not expressly teach wherein each data dictionary field comprises a user-selectable level of the hierarchy to which the data dictionary field is to be applied. However this is well known in the art as evidenced by the Powers and Wolfston teachings. Wolfston teaches a screen display containing user-selectable options that will take a user to various hierarchical levels (Wolfston; Col. 5, lines 1-7). Powers

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further teaches levels of hierarchy in an enterprise are old and well known in the art (Powers; Col. 6, lines 33-45). It would have been obvious to one of ordinary skill in the art to combine the user-selectable levels of hierarchy taught by Wolfston within the performance management system of Powers since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized the results of the combination were predictable.

11. As per claim 43, Powers teaches wherein the performance management data includes data aggregated from a first level of the hierarchy to a second level of the hierarchy to generate an aggregate value (Powers; Col. 4, line 21-41; Col. 11, line 64 to Col. 13, line 4).

12. As per claim 44, Powers teaches wherein the first level of the hierarchy is associated with a set of agents and the second level of the hierarchy is associated with a manager of the set of employees (Powers; Col. 3, line 58 to Col. 4, line 20).

13. As per claim 45, Powers teaches wherein each of the set of employees has an associated objective having a value, wherein values of the associated objective for each of the set of employees are aggregated and associated with the manager (Powers; Col. 3, line 58 to Col. 4, line 20).



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14. As per claim 46, Powers teaches wherein each of the set of employees is rated on a team objective (Powers; Col. 3, line 58 to Col. 4, line 20).

15. As per claim 47, Powers teaches wherein the performance management data is received from one or more systems (Powers; Col. 4, line 54 to Col. 5, line 2).

16. As per claim 48, Powers teaches generating a report based on a result of applying the received performance data against the data dictionary (Powers; Col. 4, line 21-41).

17. As per claim 49, Powers teaches wherein the operation associates data from a first data field with data from a second data field (Col. 11, line 64 to Col. 13, line 42).

18. As per claim 50, Powers teaches wherein the dictionary entry comprises a rule that defines a value associated with performance management data in at least one of the data fields (Col. 11, line 64 to Col. 13, line 42).

19. As per claim 51, Powers teaches wherein the rule enables a first user in the hierarchy to override a configuration setting of a second user in the hierarchy (Col. 5, lines 32-35).

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20. As per claim 52, Powers teaches wherein the configuration setting is overridden by a manager (Col. 5, lines 32-35).

21. As per claim 53, Powers teaches wherein the data dictionary further includes a user-selectable measurement period against which the operation is to be applied (Col. 6, lines 14-20).

22. As per claim 54, Powers teaches wherein the user interface is provided by a web page (Col. 2, lines 15-16).

23. As per claim 55, Powers teaches wherein the hierarchy comprises a first level, and a second level (Powers; Col. 3, line 58 to Col. 4, line 20).

24. Claims 56-61 repeat substantially the same limitations of claims 42-55 but in apparatus form. The reasons for rejection are incorporated herein.

### ***Response to Arguments***

25. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection. Examiner has addressed the arguments in regards to rejections under 35 USC 101 above. The rejection under 35 USC 102(e) has been withdrawn and a new rejection under 35 USC 103(a) has been applied.

***Conclusion***

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHELLE LE whose telephone number is (571)272-8207. The examiner can normally be reached on 8 AM - 5PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gerald O'Connor can be reached on 571-272-3600. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

9/10/09  
/Michelle Linh-Giang Le/  
Examiner, Art Unit 3686